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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
10/621,178	07/16/2003	Douglas S. Horne	8603.63	2354	
7590	04/04/2006		EXAMINER ROGERS, KRISTIN D		
Michael F. Krieger KIRTON & McCONKIE Suite 1800 60 East South Temple Salt Lake City, UT 84111			ART UNIT		PAPER NUMBER
			3736		

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/621,178

Applicant(s)

HORNE ET AL.

Examiner

Kristin D. Rogers

Art Unit

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☒ Claim(s) 8 and 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on July 16, 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Group I in the reply filed on February 21, 2006 is acknowledged. Claims 1-15 will be considered for examination.

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the motor and element 49 of the feedback loop must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the

applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

3. The disclosure is objected to because of the following informalities: Page 10, lines 19-20 beginning "Some embodiments have a sensor and logic to quickly locate the are closest..." needs revision.

Appropriate correction is required.

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Objections***

4. Claim 8 is objected to because of the following informalities: Claim 8 depends from claim 8. The Examiner is considering claim 8 to depend from claim 7 for examination. Appropriate correction is required.

5. Claim 12 is objected to because of the following informalities: Claim 12 depends from claim 12. The Examiner is considering claim 12 to depend from claim 11 for examination. Appropriate correction is required

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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7. Claims 1, 6, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Lum et al. (6391005). In regard to claims 1 and 15, Lum et al. shows a method of obtaining an electrical signal from a patient including locating a probe 150 for measuring an electrical signal of a patient's skin (column 3, lines 35-45), contacting with stationary element isolation hood of probe 152 the patient's skin, actuating motor 158 and feedback loop 104 applying pressure to the tip of probe 150 independent from pressure of the stationary hood 152 and measuring the electrical impedance (Figure 6a). In regard to claim 6, Lum et al. shows a method of stabilizing a probe against the dermal area, measuring an electrical signal value and comparing the signal value to the pressure applied and changing the future amount of pressure when a different previous electrical signal value varies from the present electrical signal value (column 6 line 50 to column 7 line 5. Claims 19-20 teach the claimed method).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lum et al. in view of Anderson (3784908). Lum et al. shows a method of obtaining an electrical signal from a patient including locating a probe, but lacks a point locator providing audible signals. Anderson teaches a method of electrical conductivity in which the dermal area of a patient is located with point locator 35 whereby the point locator 35 indicates the area of highest electrical conductivity. The point locator produces audible signals that can be observed via earphones 45 (column 5, lines 21-26). Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Lum et al. with a point locator producing audible signals as taught by Anderson for the purpose of providing an audible indication of the dermal area with substantial electrical signal.

11. Claims 3-4, 7, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lum et al. in view of Lum et al. (Figure 7B). Lum et al. shows a method of obtaining an electrical signal from a patient including locating a dermal area on a patient and contacting the area with a probe tip 150 and stationary element 152, detector 120, feedback loop 104 that provide electrical signal information, but lacks a biasing element and control of the biasing element providing electrical signals from the feedback loop. In regard to claims 3-4, 7 and 11, Lum et al. (Figure 7B) teaches a biasing element

comprising spring 176A and 176B connected to the probe 152 and probe tip 150 for controlling the pressure applied to probe tip 150 from actuating the biasing element (column 5, lines 36-50 and column 3, lines 15-27, 65-67 to column 4, lines 1-3). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Lum et al. with a biasing element controlled by feedback loop as taught by Lum et al. (Figure 7B) since such modification would provide a means for controlling the amount of pressure applied to probe tip and receiving electrical signal information.

12. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lum et al. in view of Teller et al. (20040133081). Lum et al. shows a method of obtaining an electrical signal from a patient including locating a probe, but lacks a convex probe tip. Teller et al. teaches a method of using an apparatus for detecting bioimpedance comprising a convex probe 805 comprising an abrasive bristly matrix 830 (page 20 paragraph 157 and page 25 paragraph 187 Figure 23). Therefore it would have been obvious for one having ordinary skill in the art at the time of the invention to modify Lum et al. with a convex probe tip with a bristly matrix as taught by Teller et al. for the purpose of providing a abrasive surface contacting the dermal area of a patient.

13. Claims 8, 10, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lum et al. and Lum et al. (Figure 7) as applied to claims 7 and 11 above, and further in view of Anderson. Lum et al. shows a method of locating a dermal area, but lacks a point locator providing audible signals. Anderson teaches a method of measuring electrical conductivity (conductance) in which the dermal area of a patient is

located with point locator 35 whereby the point locator 35 indicates the area of highest electrical conductivity. The point locator produces audible signals that can be observed via earphones 45 (column 5, lines 21-26). Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Lum et al. with a point locator producing audible signals as taught by Anderson for the purpose of providing an audible indication of the dermal area with substantial electrical signal given as a conductance value.

14. Claims 9 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lum et al. and Lum et al. (Figure 7) and Anderson, as applied to claims 8 and 12 above, and further in view of Teller et al. Lum et al. shows a method of obtaining an electrical signal from a patient including locating a probe, but lacks a convex probe tip. Teller et al. teaches a method of using an apparatus for detecting bioimpedance comprising a convex probe 805 comprising an abrasive bristly matrix 830 (page 20 paragraph 157 and page 25 paragraph 187 Figure 23). Therefore it would have been obvious for one having ordinary skill in the art at the time of the invention to modify Lum et al. with a convex probe tip with a bristly matrix as taught by Teller et al. for the purpose of providing a abrasive surface contacting the dermal area of a patient.

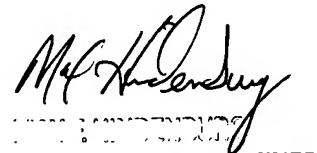
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristin D. Rogers whose telephone number is 571.272.7293. The examiner can normally be reached on Monday through Friday 8:00am - 4:30pm EST.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 571.272.4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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